

### REMARKS/ARGUMENTS

As a result of the Final Office action, Applicant's (now cancelled) claims 23, 25-31, 33-35 and 37-42 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,445,694, "Internet Controlled Telephone System," (Swartz).

Claims 24, 32 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz in view of U.S. Patent No. 6,442,242, "Multifunction Autoattendant System and Method of Operation Thereof" (McAllister, et al.).

Applicant's independent claims 43, 51 and 55 have been presented with this Request for Continued Examination (RCE) to make clear that Applicant's invention is directed, in at least part, to a technique for responding to a communication received from a sender, wherein the communication includes, *inter alia*, sender identification information. In one aspect of the invention, the sender identification information is used to search one or more remote websites for publicly accessible correlated information that is related to the sender. In one embodiment, set forth in Applicant's Detailed Description, the sender information is a caller ID. The caller ID may be used to search the Internet, or other publicly available sources of information, for information correlated with the caller ID, e.g., for an email address.

Because none of the cited references, nor any tenable combination of, or modification to, those references, discloses or suggests the subject matter of Applicant's newly presented Claims, including, in pertinent part, searching remote websites for publicly accessible information that is correlated to the sender of the communication, Applicant respectfully maintains that Claims 43-62, as presented here, are patentable over the cited art.

Specifically, the "search" disclosed in Swartz differs in significant respects from the search disclosed and claimed by Applicant. Swartz' search is not performed on remote websites for publicly accessible data. Rather, that search is highly restrictive in that Swartz' "search" embraces only such information as has been previously entered by a subscriber, with respect to frequently called numbers. The subscriber-provided information is stored in a proprietary host services processor.

Accordingly, Applicant respectfully maintains that independent Claims 43, 51 and 55 are patentable over Swartz.

A rejection of a claim under 35 U.S.C. § 102 requires that a prior art reference disclose expressly or inherently every limitation contained in the claim. *Rowe v. Dror*, 42 U.S.P.Q.2d 1550 (Fed. Cir. 1997). If any claimed element is absent from the reference, there is no anticipation. *Id.* A prior art reference must disclose each claimed element clearly enough to prove its existence in the prior art. *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 U.S.P.Q.2d (Fed. Cir. 1984).

It is not enough, however, that the prior art references disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). The Federal Circuit has indicated that "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Id.* The anticipation determination is to be viewed from the perspective of one having ordinary skill in the art.

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

Applicant's independent Claims 43, 41 and 55 respectively recite a method, an apparatus and an article of manufacture that are directed to a technique for responding to a communication received from a sender. The communication, which may be a telephone call, includes sender identification information, e.g., a caller ID. The sender identification information is used to search remote websites for publicly accessible correlated information that is related to the sender. In this respect, Swartz, at Column 9, lines 27-39, discloses only a system in which a host services computer matches a telephone number to a "phone book" database. The "phone book" consists of frequently called listings that have been previously entered (manually, presumably) by the subscriber and contains only such information as is in the possession of the subscriber. Swartz at Column 10, lines 38-53.

Accordingly, based on the above salient differences between the subject matter that is set forth in Applicant's Claims 43, 51 and 55 and the subject matter disclosed in Swartz, Applicant respectfully maintains that Claims 43, 51, and 55 are patentable under 35 U.S.C. § 102(e) over Swartz.

Applicant's Claims 44-50, 52-54 and 56-62 depend, respectively, from independent Claims 43, 51 and 55 and are, for at least this reason, likewise patentable under 35 U.S.C. § 102(e) over Swartz.

Furthermore, with particular reference to Applicant's independent Claim 51, it must be noted that Claim 51 is here directed to an apparatus that comprises a search director to

search one or more remote websites, using sender identification information, or publicly accessible correlated information that is related to the sender. Swartz neither discloses, expressly or inherently, nor suggests the search director that is recited in Applicant's independent Claim 51.

Swartz, at Col. 9, ll. 26-39, discloses that the sender's ANI information may be "matched" against a "phone book" database. However, the database is not interrogated (i.e., searched) by a search director. Rather, the user in Swartz obtains information from the phone book database by checking on the hyperlink anchor text "Phone book," and subsequently checking on an entry in alphabetical listing of frequently called numbers. Accordingly, no search director is required by, or suggested in Swartz. Applicants' Claims 52-54 depend from Claim 51 and are, for at least this additional reason, patentable over the cited art under 35 U.S.C. §102.

With reference to rejections under 35 U.S.C. § 103(a), Applicant respectfully submits that there exists no legally tenable modification to, or combination of, Swartz and McAllister, et al. that renders Applicant's Claims 44, 52 and 56 unpatentable under 35 U.S.C. § 103(a).

In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, it is clear that an obviousness determination requires that the invention as a whole would have been obvious when made a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 U.S.P.Q. 193 (Fed. Cir. 1983).

Most, if not all, inventions arise from a combination of old elements. See *In Re Rouffet*, U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual element claimed is insufficient to defeat patentability of the invention as a whole. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The motivation suggestion or teaching to combine references may come explicitly from the statements in the prior art, the knowledge of one with ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether an Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, it must provide particular findings related thereto. *In re Dembiczak*, 50 U.S.P.Q.2d at 1617 (Fed. Cir. 1999). Broad conclusory statements standing alone are not "evidence." *Id.*

That is to say, with respect to the subject Patent Application, there must be provided particular factual findings that support an assertion that a skilled artisan would have combined or modified the express disclosures of Swartz and McAllister, et al. to develop the subject matter recited in the Applicant's Claims 44, 52 and 56. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317. The specific subject matter set forth in Claims 44, 52 and 56 includes, in pertinent part, encoding an audio message received from a sender, composing an email message that includes the encoded audio message, and transmitting the

email to a predetermined email address. Although conceding, *arguendo*, that McAllister, et al. discloses attaching an encoded audio message to an email, Applicant maintains that nothing explicit or implicit in the disclosure of Swartz or McAllister, et al. suggests that those disclosures may be advantageously combined, and neither Swartz nor McAllister, et al. contains motivation to do so.

In rejecting Applicant's Claims, it is not sufficient to simply assert that "it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the features of encoding the audio message; composing an email message that includes the encoded audio message and transmitting the email message to a predetermined email address, as taught by McAllister [sic], into view [sic] of Swartz in order to forward the voice messages to called party using a data network such as Internet."

In addition, it is clear that any rejection that is formulated by deconstructing the elements of Applicant's Claims (particularly Claims 44, 52 and 56) and identifying individual ones of those elements in either Swartz or McAllister, et al. represents no more than a hindsight reconstruction of Applicant's disclosed invention.

#### CONCLUSION

In view of these Remarks, the subject Patent Application, as here amended, is believed to be in condition for allowance. The Examiner's prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504.

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Respectfully submitted,



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